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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/225,080 01/04/99 AU-YOUNG J PF-0066-2-DI

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HM22/0313

EXAMINER

CANELLA, K

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

03/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/225,080

Applicant(s)
Au-Young

Examiner
Karen Canella

Group Art Unit
1642



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 days month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 13 and 17-33 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 13 and 17-33 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 13, drawn to an antisense nucleic acid, classified in class 536, subclass 24.5.
 - II. Claim 17, drawn to a hybridization based detection method, classified in class 435, subclass 6.
 - 389 III. Claim 18, drawn to a polypeptide, classified in class 530, subclass 350.
 - IV. Claims 19, 22 and 24, drawn to an antibody, classified in class 530, subclasses 388.1 and 389.1.
 - V. Claims 21 and 23, drawn to a method of making an antibody, classified in class 514, subclass 2.
 - VI. Claims 20 and 33, drawn to an antibody based detection method, classified in class 435, subclass 7.1
 - VII. Claims 31 and 32, drawn to a method of treatment comprising administering an antibody, classified in class 424, subclass 139.1.
 - VIII. Claim 25, drawn to a method of screening for agonist compounds, unclassifiable.
 - IX. Claim 27, drawn to a method of screening for antagonist compounds, unclassifiable.
 - X. Claim 26, drawn to a pharmaceutical composition of an agonist, unclassifiable.
 - XI. Claim 28, drawn to a pharmaceutical composition of an antagonist, unclassifiable.
 - XII. Claim 29, drawn to a method of treatment comprising administering an agonist, unclassifiable.
 - XIII. Claim 30, drawn to a method of treatment comprising an antagonist, unclassifiable.

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2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antisense nucleic acid of Invention I can be used in an in vivo treatment.

3. Inventions IV and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Invention IV can be used for an in vivo treatment method.

4. Inventions IV and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Invention IV can be used in an in vitro diagnostic assay.

5. Inventions X and XII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the agonist of Invention X can be used in an in vitro diagnostic assay.

6. Inventions XI and XIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the

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product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Invention XI can be used in an in vitro diagnostic assay.

7. Inventions I, III, IV, X and XI are structurally and functionally different products which are made by different methods and have different uses. The examination of all groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

8. The methods of Inventions II, VI, VII, VIII, IX and XII differ in the method objectives, method steps and parameters and in the reagents used.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

10. Because of the complexity of the claims, telephonic restriction was not attempted.


11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i)..

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzel, can be reached on (703) 308-4310. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Canella, Ph.D.
Patent Examiner, Group 1642
March 9, 2000



NANCY A. JOHNSON, PH.D
PRIMARY EXAMINER